

Changes to Patent Practice of Procedure - Final Rule

62 Fed. Reg. 53131 (October 10, 1997);
1203 Off. Gaz. Pat. Office 63 (October 21, 1997)

Condensed - Subject Matter Summary II

The following represents highlights from the final rule "Changes to Patent Practice and Procedure."

Filing of Applications

All applications are now to be filed under rule 53 as prior rules 60 and 62, for filing of continuing applications (continuations, divisions and continuations-in-part), are eliminated:

continuation and divisional applications, similar to old rule 60, may continue to be filed with a copy of an oath or declaration and with the ability to delete one or more inventors, under § 1.53(b).

A new type of application, a continued prosecution application, CPA has been created, § 1.53(d), which:

will be processed directly in the Group rather than in Office of Initial Patent Examination as it utilizes the same file jacket, application no. and filing date as the prior complete application:

fax submission direct to the Group is permitted (with the filing date being the date of receipt if the receipt and transmission dates differ).

A CPA application:

can name the same or fewer than all the inventors named in the prior application,

but may not:

be a CIP application, or

claim priority to an immediate prior application that was filed before June 8, 1995.

The naming of the actual inventors is no longer required to obtain a filing date for an application pursuant to amendments to §§ 1.41 and 1.53. Where an application is filed without an executed oath or declaration under § 1.63 but sets forth an inventor's name:

the subsequent submission of an oath or declaration with a different inventive entity will set forth the inventorship, § 1.48(f), eliminating the need for a § 1.48(a) petition, and

where an inventor's name is not originally set forth, until such time as an executed oath or declaration is submitted, an alphanumeric identifier should be used.

Deceptive Intent Issues

The separate verification requirements have been eliminated in rules 1.6, 1.8, 1.10, 1.27, 1.28, 1.48, 1.52, 1.55, 1.69, 1.102, 1.125, 1.137, 1.377,, 1.378, 1.804, 1.805, 3.26, and 5.4, due to amendment of §§ 1.4 and 10.18.

Reissue oaths or declarations under § 1.175 have been simplified:

only one error being corrected need be identified instead of all errors,

only a general statement as to a lack of deceptive intent is required instead of a detailed showing of facts and circumstances as to how each error arose or occurred, and

only one supplemental oath or declaration need be supplied prior to allowance stating all errors not covered by the original oath or declaration arose without deceptive intent instead of a new oath or declaration with each amendment.

Petitions to correct inventorship in pending applications other than reissue applications, § 1.48, and in patents, § 1.324, have been liberalized:

diligence requirement for filing of petition deleted,

parties submitting a statement of facts as to how the error occurred changed to those being added or deleted rather than all (§ 1.324 requires statement of agreement or nondisagreement from the other inventors), and

statements of facts may now simply state lack of deceptive intent rather than supply facts and circumstances, and are not required to be verified.

Small entity status can be obtained without a new statement in CPA and reissue applications, and payment of a small entity fee in a continuing or reissue application substitutes for the required reference to the statement in the prior application or patent, § 1.28(a).

For erroneous payments of small entity fees, the submission of the fee deficiency is a representation that status was requested in good faith and a verified statement of facts is no longer required. § 1.28(c).

Actions by assignees under § 3.73(b) no longer require: a statement that the evidentiary documents have been reviewed, and a certification that title is in the assignee seeking to take action.

Appeals

New grounds of rejection are prohibited in examiner's answers, requiring reopening of prosecution, § 1.193(a)(2), but if a § 1.116 amendment is approved for entry, rejection(s) in the action appealed from may be permitted to be additionally applied to the claims that are to be amended where applicant was advised of the additional rejection(s).

Appellants have the right to the last submission. Reply briefs need not address new points of argument raised by the examiner to be admitted. New issues raised in a reply brief can only be responded to by reopening of prosecution. § 1.193(b)(1).

A supplemental brief filed after reopening of prosecution requesting reinstatement of the appeal is an appropriate response. § 1.193(b)(1).

The BPAI now has authority to enter a rejection of allowed claims rather than merely setting forth a binding recommendation.

Time Frames

Subject matter relating to abandoned applications and lapsed patents (§§ 1.139, 1.155, 1.316 and 1.317) have been combined into § 1.137.

The one year bar on unintentional delays under § 1.137(b) has been removed and the rule clarified that the entire delay, from the due date for reply until the filing date of a grantable petition, must have been unintentional.

The terminal disclaimer requirement previously applicable only to unavoidable delay has been extended to unintentional delay for all design applications and all utility applications filed prior to June 8, 1995 without the previous six month grace period. § 1.137(c).

Five-month extensions of time rather than four-month extensions are available under § 1.136(a)(1) subject to the maximum statutory period for response.

Petitions for extension of time can now be provided for by a previous general authorization for extension of time, the payment of the extension of time fee, or the general authorization to pay additional fees. § 1.136(a)(3).

Incomplete replies to non-final actions, containing a bona fide attempt to reply, may be given a time period extendible under § 1.136 to reply rather than a non-extendible time limit. § 1.135(c).

Protests containing additional prior art submissions are no longer barred under the former one protest per protester rule, but timely submission remains a factor. § 1.291(c).

Miscellaneous

The manner of making amendments in reissue applications, § 1.121(b), has been made consistent with reexamination proceedings, § 1.530(d):

provides for cancellation of an entire paragraph from the specification (without it being rewritten in brackets),

hand-entry of five words or less is no longer permitted,

status of all patent and all added claims must be supplied with each claim amendment even for added but subsequently canceled claims, and

support for each claim amendment when originally submitted must be supplied.

A right to submit a substitute specification is now provided for where it is accompanied by a statement of no new matter and a marked-up copy. § 1.125(b).

For design drawings:

the prohibition against color drawings and photographs is replaced by a petition procedure, § 1.152(a)(2), and

it is clarified that all matter (e.g., color, indicia) in original informal drawings or photographs not disclaimed on filing is an integral part of the disclosure and claims and cannot be removed on filing of the formal drawings.

Petitions to expunge are now specifically provided for in § 1.59.

An oath or declaration is now required to state the full name and post office address of each inventor.